

Appl. No.: 09/787,190
Group Art Unit: 1617
Applicants' Response to Paper No. 17

REMARKS

Claims 7-25 are currently pending in the present application.

In Paper No. 17, the Examiner rejects claims 7-10, 13-14, 16-20 and 23 under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,099,828 of Kajino, *et al.* (hereinafter referred to as "Kajino"). Specifically, the Examiner contends that Kajino discloses water-based hair treatment compositions containing 10 to 15% by weight of propylene carbonate and an oil component, citing Tables 9, 11 and 13 of the Kajino reference. The Examiner also contends that Kajino discloses the use of the propylene carbonate as a penetration enhancer. The Examiner acknowledges that Kajino fails to explicitly teach or suggest the use of such a carbonate as a moisturizer. However, the Examiner argues that "the topical application of composition comprising propylene carbonate . . . must necessarily provide the recited moisturizing effect." (See, Paper No. 17, p.3). On the basis of this inherency argument, the Examiner argues that the claims are anticipated. Applicants respectfully traverse the Examiner's rejection and the arguments and contentions in support thereof for the following reasons.

In order for a rejection under 35 U.S.C. §102 to be proper, each and every element of the claimed invention must be taught, either expressly or inherently, in a single prior art reference. (See, e.g., M.P.E.P. §2131). Moreover, with respect to inherent disclosure, it is well-settled that "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." (See, M.P.E.P. §2112, citing Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (*emphasis in original*)).

Applicants respectfully submit that the Examiner has not provided the required basis-in-fact and/or technical reasoning necessary to substantiate an anticipation rejection based on an inherency argument.

Kajino discloses hair treatment compositions which contain: (A) a lactam compound of the formula 1 disclosed therein; (B) a water-soluble macromolecule; (C) an acid dye; and (D) a penetration promoting auxiliary agent for increasing the penetration promoting

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action of the lactam compound, wherein the auxiliary agent can be selected from ethylene carbonate and propylene carbonate.

The Examiner has argued that the disclosed hair treatment compositions "must necessarily provide" the claimed moisturizing effect. Kajino discloses hair treatment compositions which contain, among other things, acid dyes and ethanol. Both acid dyes and ethanol can have damaging, drying effects on substrates such as skin and hair. It is unreasonable to argue, without any further factual basis, that a composition containing an acid dye and ethanol "must necessarily" provide a moisturizing effect simply because a carbonate, used as a penetration promotion agent, is also included in the composition.

Applicants respectfully submit that the Examiner has failed to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. Accordingly, Applicants submit that each and every element of the claimed invention is not taught by Kajino, and thus the reference fails to anticipate the claimed invention. Thus, reconsideration and withdrawal of the rejection under 35 U.S.C. §102 are respectfully requested.

In Paper No. 17, the Examiner rejects claims 15 and 24 under 35 U.S.C. §103(a), as being unpatentable over Kajino. Specifically, the Examiner contends that Kajino discloses the claimed invention, as set forth above in relation to the rejection under 35 U.S.C. §102(e), but acknowledges that Kajino fails to teach the additional additives of claims 15 and 24. The Examiner argues that it would have been obvious to one of ordinary skill in the art to have added additional hair conditioning oils.

Applicants respectfully traverse the Examiner's rejection and the arguments and contentions in support thereof for the following reasons. As set forth above, Applicants submit that Kajino does not teach each and every element of the claimed invention and that the allegedly inherent moisturizing characteristic does not necessarily flow from the teachings thereof. As each and every element of the claimed invention is not taught or suggested by the cited reference, the requirements for establishing a *prima facie* case of obviousness are not satisfied.

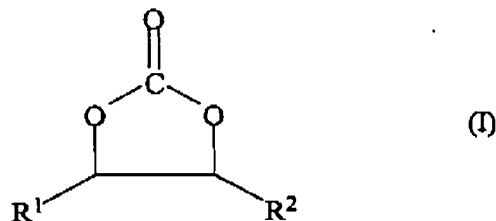
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Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) based on Kajino are respectfully requested.

In Paper No. 17, the Examiner rejects claims 7-9, 11-12, 17-19 and 21-22 under 35 U.S.C. §103(a), as being unpatentable over U.S. Pat. No. 4,801,331 of Murase (hereinafter referred to as "Murase"). Specifically, the Examiner contends that Murase discloses a nail lacquer remover containing from 30 to 65% by weight of a solvent such as propylene carbonate or glycerin carbonate. Additionally, the Examiner contends that Murase discloses "that such solvents overcome the disadvantage of the prior arts 'which tend to extract oils and moisture from the nails'." (See, Paper No. 17, p. 4). The Examiner argues that Murase teaches that cyclic carbonates do not remove oils and moisture from nails, and therefore, that it would have been obvious to one of ordinary skill in the art to have expected the topical application of the composition to have provided moisturizing effects. On this basis the Examiner argues that the claims are unpatentable.

Applicants respectfully traverse the Examiner's rejection and the arguments and contentions in support thereof for the following reasons.

To begin with, Applicants would like to reiterate that one embodiment of the claimed invention is directed to methods of moisturizing a substrate, comprising: (a) providing a substrate to be moisturized; (b) providing a cosmetic or pharmaceutical composition comprising an emulsion having an oil phase and an aqueous phase, the emulsion comprising a cyclic carbonate of the general formula (I):



wherein R^1 and R^3 each independently represent hydrogen or a linear or branched alkyl group having from 1 to 4 carbon atoms, and R^2 represents a linear or branched alkyl group having from 1 to 4 carbon atoms or $-CH_2OR^3$; and (c) contacting the substrate with the cosmetic

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composition. Another embodiment of the claimed invention is directed to methods of enhancing the moisturizing properties of a composition.

In order to establish a *prima facie* case of obviousness based upon a single reference, and thus shift the burden of proving non-obviousness onto Applicants, the Examiner MUST satisfy each of the following three criteria: (1) the reference must contain a teaching or suggestion which would motivate one of ordinary skill in the art to modify the reference as suggested by the Examiner (it is not sufficient to say that the reference can be modified without a teaching in the cited reference to suggest the desirability of such a modification); (2) there must be a reasonable expectation of success; and (3) the reference must teach or suggest each and every element of Applicants' claimed invention. The teaching or suggestion to modify the cited art and the reasonable expectation of success must both be found in the prior art and not in Applicants' Specification. (M.P.E.P. §2143).

Murase does not teach the topical application of an emulsion comprising a cyclic carbonate of the general formula (I). Murase is directed to the use of a transparent, gel, nail lacquer remover. The reference does not teach or suggest the topical application of an emulsion to a substrate to be moisturized. The Examiner has argued that the reference suggests the moisturizing effect. Applicants disagree. The reference simply points out that prior art solvents extract oil and moisture from nails. Without the application of improper hindsight based on Applicants' own Specification, this does not equate to a teaching or suggestion that the disclosed nail lacquer remover will in fact moisturize nails. At best, this indirect "teaching" might be said to indicate that the disclosed gel nail lacquer remover does not extract oils and moisture as badly as the prior art solvents. One of ordinary skill in the art would not have a reasonable expectation of successfully moisturizing a substrate by applying a cyclic carbonate based upon the teachings of Murase.

Thus, Murase fails to teach or suggest each and every element of the claimed invention in that the reference fails to teach or suggest the topical application of an emulsion comprising a cyclic carbonate and it fails to teach or suggest the moisturization of a substrate by applying such a composition. Additionally, Murase does not contain any teaching or suggestion

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which would motivate one of ordinary skill in the art to modify the reference in order to arrive at the claimed invention. Nothing in Murase would motivate the use of an emulsion, when the reference specifically teaches the use of a gel. Finally, as set forth above, one of ordinary skill in the art would not have a reasonable expectation of success.

Accordingly, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness as none of the criteria necessary to establish a *prima facie* case of obviousness has been satisfied. Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) based on Murase are respectfully requested.

Lastly, in Paper No. 17, the Examiner rejects claim 25 under 35 U.S.C. §103(a), as being unpatentable over Kajino, in view of Murase and further in view of U.S. Pat. No. 5,993,837 of Calello, *et al.* (hereinafter referred to as "Calello"). Specifically, the Examiner contends that the invention is taught by Kajino and Murase, except for the use of glycerine carbonate for hair care. However, the Examiner argues that Murase teaches the equivalency of propylene carbonate and glycerine carbonate. The Examiner goes on to contend that Calello teaches the use of propylene carbonate as a solvent for cosmetics.

Applicants respectfully traverse the Examiner's rejection and the arguments and contentions in support thereof for the following reasons. First, Kajino fails to teach or suggest the moisturization of a substrate via the topical application of a composition comprising a cyclic carbonate, either explicitly or inherently. Second, Murase fails to remedy this deficiency. Murase does not teach the use of an emulsion. Finally, Calello also fails to remedy the deficiencies of the Kajino and Murase references. Calello does not teach the use of a cyclic carbonate in an emulsion to moisturize a substrate.

Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness. Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) based on the combination of Kajino, Murase and Calello are respectfully requested.

In view of the remarks set forth above, Applicants submit that all pending claims patentably distinguish over the prior art of record and known to Applicants, either alone or in

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combination. Accordingly, reconsideration, withdrawal of the rejections and a Notice of Allowance are respectfully requested.

Respectfully submitted,

THOMAS GASSENMEIER, *et al.*

November 20, 2003 By: 
(Date)

AARON R. ETTELMAN
Registration No. 42,516
COGNIS CORPORATION
300 Brookside Avenue
Ambler, PA 19002
Telephone: (215) 628-1413
Facsimile: (215) 628-1345
E-Mail: AARON.ETTELMAN@COGNIS-US.COM

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